



UNITED STATES PATENT AND TRADEMARK OFFICE

R-2000-129

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 2023-
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JAN 5 2001

In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 2, 3, 18 and 44 of the morning section, and questions 6, 16, 28, 36 and 48 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On July 19, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. **There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true.** Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded credit for morning questions 2 and 44. Accordingly, petitioner has been granted two additional points on the Examination. However, no credit has

been awarded for morning questions 3 and 18, nor afternoon questions 6, 16, 28, 36 and 48.

Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

The model answer is choice (E). Choice (E) is correct because both (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. Choices (A) and (C) are incorrect. MPEP § 608.01(n) ("[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly").

Petitioner argues that choice (B) is the only correct answer because the statement in answer (D) is incorrect. Petitioner contends that it is incorrect to conclude that a multiple dependent claim is properly construed to incorporate by reference to *all* of the limitation of *each* of the particular claims to which it refers. Petitioner appears to interpret this statement as meaning that the multiple dependent claim references the limitations of the claims from which it depends aggregately instead of in the alternative.

Petitioner's argument has been fully considered but is not persuasive. Petitioner misinterprets the statement in answer (D). Answer (D) is modeled after the language in 37 CFR 1.75(c), which states, "a multiple dependent claim shall be construed to incorporate by reference

all the limitations of each of the particular claims in relation to which it is being considered.”

Both the language of answer (D) and the language of the rule anticipate referencing the claims from which the multiple dependent claim depends in the alternative rather than aggregately.

MPEP 608.01(n) sets forth the proper interpretation of the language of the rule. Therefore,

answer (E) is the best answer because both answers (B) and (D) are correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?

- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
- (B) Favoring the prompt and widespread disclosure of inventions.
- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice (D). Increasing the economic value of a patent by extending the effective term of the patent up to one year is not a policy underlying the public use bar of 35 U.S.C. 102(b).

Petitioner argues that the most correct answer is choice (C). Petitioner argues that allowing inventors a reasonable amount of time following sales activities to determine the potential economic value of a patent is not a policy underlying the public use bar of 35 U.S.C. 102(b).

Petitioner points out that there is a difference between the “public use” and “on sale” bars under

35 U.S.C. 102(b), and appears to argue that since choice (C) refers to "sales activities," it can not be a policy under the "public use" bar of 35 U.S.C. 102(b). Petitioner further argues that case law which pre-dates the most recent MPEP revision, but is not cited therein, should not be considered in the answers to the examination.

Petitioner's arguments have been fully considered but they are not persuasive. The Court of Appeals for the Federal Circuit has repeatedly stated that one of the policies underlying the public use bar of 35 U.S.C. 102(b) is allowing inventors a reasonable amount of time following sales activities to determine the potential economic value of a patent. See *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996); *Tone Brothers v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994); and *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 USPQ 402 (Fed. Cir. 1985). The Federal Circuit lists all of the answer choices, with the exception of choice (D) (i.e., increasing the economic value of a patent by extending the effective term of the patent up to one year) as policies underlying the public use bar of 35 U.S.C. 102(b).

Further, note that the directions to the examination do not exclude all case law which pre-dates the most recent MPEP revision from consideration. The directions merely state that the policy, practices and procedures embodied in the MPEP should be considered in light of any subsequent case law or *Official Gazette* notices which may modify them. Such statement does not exclude from consideration the patent policy, practices and procedures which are embodied in case law. Therefore, answer (D) is the best answer. No error in grading has been shown.

Petitioner's request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. In the course of prosecuting a patent application for his client, Smith did not receive a Notice of Allowance and Issue Fee Due from the PTO. Fifteen months after submitting a reply to a final rejection, Smith received from the PTO a Notice of Abandonment advising that the application became abandoned for failure to pay the issue fee. Which of the following actions, if any, accords with proper PTO practice and procedure, and is most likely to succeed in protecting the interests of Smith's client?

- (A) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable, accompanied by the issue fee then in effect, and any required terminal disclaimer.
- (B) File a petition to revive the application including a statement that the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional, and required terminal disclaimer.
- (C) File a timely petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.
- (D) All of the above.
- (E) None of the above.

The model answer is choice is (C). To properly revive an abandoned application that went abandoned because the practitioner did not receive a mailing from the office, practitioner should timely file a petition to withdraw the holding of abandonment accompanied by a statement that the Notice of Allowance and Issue Fee Due was not received, and that a search of the file jacket and docket records indicates that the Notice of Allowance and Issue Fee Due was not received. Include with the petition a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

Petitioner selected answer (D). Petitioner argues that answers (A), (B), and (C) are all correct, and therefore choice (D) is correct. Petitioner argues that answers (A) and (B) each

recite filing of "grantable petitions", and that grantable petitions by definition include the proper fee.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (C) is correct because it sets forth the modified showing discussed in MPEP § 711.03(c), item subsection II, and complies with the fact noted in MPEP § 711.03(c), subsection I, that a petition to withdraw holding of abandonment does not require a fee. The petition to withdraw the holding of abandonment **does not require the payment of a fee** and is the best way to protect the interest of the client.

Answer choices (A) and (B) do not include the payment of the petition fees, which are required under a petition to revive an abandoned application. See 37 C.F.R. §§ 1.17(l) and (m). **Note that the rules distinguish between a "grantable petition" and the "petition fee" which must be submitted therewith.** According to both 37 C.F.R. § 1.137 (a) and (b), a "grantable petition pursuant to this paragraph must be accompanied by: . . . required reply . . . petition fee . . .". Even if choices (A) and (B) did include the proper petition fees, they would not constitute the best way to protect the interest of the client, since choice (C) requires no fee.

Contrary to petitioner's contention, choices (A) and (B) do not recite the filing of "grantable petitions." These answers only set forth that the **statements regarding delay** recite that "the entire delay in paying the issue fee, from the due date for the payment of the fee until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) [(b)], was unavoidable [unintentional]." These answers do not state that the petitions filed are actually grantable. Further, choice (A) is also incorrect because a mere statement that the delay was "unavoidable" is insufficient under 37 C.F.R. § 1.137(a).

Additionally, either of the petitions to revive in choices (A) and (B) may require a Terminal Disclaimer, which is not the best way to protect the client's interest. Choice (C) is the best answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.

- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner argues that the most correct answer is choice (E), because (A), (B), (C) and (D) are each incorrect. Petitioner argues that none of the statements regarding the relevance of "nearly simultaneous invention" by Debbie and Billie are correct. Petitioner asserts that since MPEP 2141.03 does not refer to "nearly simultaneous invention" as being evidence of the level of skill in the art, choice (B) is not correct. Petitioner further argues that neither the MPEP nor the case law refers to or supports "nearly simultaneous invention" as being evidence of the level of skill in the art. Petitioner further argues that case law which pre-dates the most recent MPEP revision, but is not cited therein, should not be considered in the answers to the examination.

Petitioner's arguments have been fully considered but they are not persuasive. Nearly simultaneous invention may be evidence of the level of skill in the art at the time of the invention. See *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986) ("...evidence of contemporaneous invention is probative of "the level of knowledge in the art at the time the invention was made.""). See also *International Glass Co. v. U.S.*, 159 USPQ 434, 442 (US Cl Ct 1968) ("The fact of nearsimultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art."). Choice (B) finds clear support in the cited case law. Further, note that the directions to the examination do not exclude all case law which pre-dates the most recent MPEP revision from consideration. The directions merely state that the policy, practices and procedures embodied in the MPEP should be considered in light of

any subsequent case law or *Official Gazette* notices which may modify them. Such statement does not exclude from consideration the patent policy, practices and procedures which are embodied in case law. Therefore, choice (B) is correct, and choice (E) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is true?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
- (B) The 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is extendable under 37 CFR 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
- (E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E). When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

Petitioner argues that choice (E) is incorrect because a claim for foreign priority does not have to be made in the oath or declaration. Petitioner also argues that (B) is true because under 37 CFR 1.136, there is not an exception specified that relates to 37 CFR 1.181(f). Further, petitioner argues that 37 CFR 1.181(f) does not require that the petition be dismissed as untimely.

Petitioner's arguments have been fully considered but they are not persuasive. In regard to

choice (E), see MPEP 1414, "Content of Reissue Oath/Declaration," and 37 CFR 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 CFR 1.63, including 1.63(c) relating to a claim for foreign priority. When desiring to claim foreign priority in a reissue application, the reissue oath or declaration must include the foreign priority claim.

In regard to choice (B), the 2-month period for filing a petition mentioned in 37 CFR 1.181(f) is not extendable under 37 CFR 1.136(a). The two-month time period is not extendable under 1.136(a) since the time is within the discretion of the Commissioner. 37 CFR 1.181(f) provides that any petition under that rule which is not filed within 2 months from the action complained of may be dismissed as untimely. Choice (B) is incorrect and Choice (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. Which of the following is true?

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.
- (E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B). At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.

Petitioner argues that there is no correct answer because all of the statements are false. Petitioner argues that the statement in choice (B) violates 35 U.S.C 32 by suspending or excluding practitioners without adequate notice and opportunity for a hearing. Petitioner further argues that this violates "due process" and the 5th Amendment.

Petitioner's arguments have been fully considered but they are not persuasive. At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register. See 37 CFR 10.11(b). Note that choice (B) only relates to removing names from the register, not the suspension or exclusion of practitioners under 35 U.S.C 32. See 37 CFR 10.15. Furthermore, contrary to petitioner's argument that choice (B) violates the Due Process Clause, the letter sent by the Director of Enrollment is a notice and the letter is sent for the purpose of ascertaining whether they wish to remain on the register. 37 CFR 10.11(b) also provides that the name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in 37 CFR 1.21(a)(3). Choice (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

- (A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.
- (B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.
- (C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.
- (D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.
- (E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice is (D). With respect 35 U.S.C. § 103, in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

Petitioner selected answer (B). Petitioner argues that since ascertaining the differences between the prior art and the claims is one of the factual inquiries enunciated in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) and MPEP 2141, choice (B) is correct. Petitioner also argues that choice (D) is partially incorrect.

Petitioner's arguments have been fully considered but they are not persuasive. Choice (D) is the most correct answer. "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..."

In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); MPEP 2141.02 (section styled,

"Disclosed Inherent Properties Art Part of 'As A Whole' Inquiry").

In regard to choice (B), the question under 35 U.S.C. § 103 is whether the claimed invention **as a whole** would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Petitioner correctly states that ascertaining the differences between the prior art and the claims is **one** of the factual inquiries in determining obviousness under 35 U.S.C. § 103. Contrary to petitioner's contention, that is not the statement set forth in choice (B). Choice (B) states that the question of obviousness under 35 U.S.C. § 103 is **resolved** by determining whether the differences between the prior art and the claims would have been obvious. However, as petitioner acknowledges, the differences between the prior art and the claims is only **one** of the factual determinations to be made under *Graham v. Deere*. The **resolution of the issue of obviousness under 35 U.S.C. § 103 is not "whether the differences between the prior art and the claims would have been obvious," but rather "whether the claimed invention as a whole would have been obvious."** Choice (B) is not the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

No error in grading has been shown as to morning questions 3 and 18, and afternoon questions 6, 16, 28, 36 and 48. Petitioner's request for credit on these questions is denied. The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s]

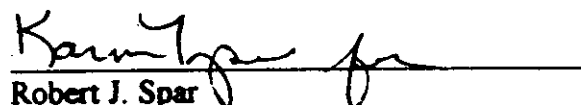
unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.).

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.


Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy